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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,062	01/07/2004	Mamoru Osada	CANO-0111	2460
37013 7590 10/15/2010 ROSSI, KIMMS & McDOWELL LLP. 20609 Gordon Park Square, Suite 150 Ashburn, VA 20147				
EXAMINER				
WEST, THOMAS C				
ART UNIT		PAPER NUMBER		
3621				
NOTIFICATION DATE		DELIVERY MODE		
10/15/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail@rkmlegalgroup.com

# Office Action Summary

**Application No.**

10/753,062

**Applicant(s)**

OSADA, MAMORU

**Examiner**

THOMAS WEST

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. In response to the Restriction dated August 5, 2010, applicant elected invention II, without traverse, directed to claims 12 and 13, drawn to a license management system.
2. Claims 12, 13 are currently pending and have been examined.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description" 37 CFR 1.75(d)(1). See section MPEP 2111 [R-5]. Claims 12, 13 recite "encrypting unit", "encrypted licensing condition", "designating unit", "first storage unit", "second storage unit", "changing unit", "counting unit", all of which lack antecedent basis in the specification, rendering them indefinite.
5. Further, the specification paragraph 105, regarding the "license information is invalid", makes no reference to a "changing unit". The Examiner questions the

invalidation of license information due to certain license limitations reached. It appears from the specification, that in fact, the license information is acting as it should in preventing certain actions the license governs. Therefore, the Examiner interprets herein that the license information has prevented certain actions based on license limitations. To invalidate certain license information would prevent certain actions from being controlled by that license information, such as controlling copy counts. Further, the term unit is indefinite since it is unclear whether a unit refers to software, hardware or both.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12, 13 are rejected under U.S.C. 103(a) as being unpatentable over Nakamura (Nakamura), U.S. Patent Application No. 20020143568, in view of Wang, US Patent Application No. 20020198843.

**Claims 12, 13:**

Nakamura discloses the following limitations:

an image forming apparatus having a controller and a program module, wherein the program module is adapted to control a scanner

engine to carry out a scanning process and a printer engine to carry out a printing process; and (29, 30)

an information processing apparatus, (38)

wherein the information processing apparatus comprises:

a setting unit adapted to set a licensing condition as a condition of the program module installed in the image forming apparatus; (41-43-43, 50, 88-91, 95)

including information for identifying the program module installed in the image forming apparatus, apparatus identifying information for identifying the image forming apparatus, and the encrypted licensing condition, (95-98 )

wherein the license information further includes a total number of print surfaces the program module is allowed to process and a total number of original surfaces the program module is allowed to process; and (50, 62)

wherein the image forming apparatus comprises:

a designating unit adapted to receive an instruction from a user to designate a storage destination of the license information stored in the first storage unit based on the received instruction; (107-109)

a changing unit adapted to change a setting for starting the program module so that the program module starts when the controller of the image forming apparatus is started, in the case where the

apparatus identifying information included in the license information stored in the second storage unit identifies the image forming apparatus, and the information for identifying the program module included in the license information identifies the program module installed in the image forming apparatus; (50, 62)

a counting unit adapted to count up, when the changing unit changes the setting for starting the program module so that the program module starts when the controller of the image forming apparatus is started, values of used resources of the program module, the values being managed in a table, wherein when the program module controls the scanner engine to carry out the scanning process, the counting unit counts up a total number of original surfaces scanned, while when the program module controls the printer engine to carry out the printing process, the counting unit counts up a total number of print surfaces printed in the printing process; and (50, 62)

wherein the changing unit changes the setting for starting the program module so that the program module does not start when the controller of the image forming apparatus is started, in the case where the determining unit determines that the license information is invalid to disable the program module. (55, 88)

Nakamura discloses the limitations above, but does not disclose the following, but Wang does:

an encrypting unit adapted to encrypt the licensing condition set by the setting unit using a public key to generate license information, (17)

a first storage unit adapted to store the license information; (107-109)

an obtaining unit adapted to obtain based on the designated storage destination, the license information from the information processing apparatus; (107-109)

a decrypting unit adapted to decrypt the encrypted licensing condition included in the license information stored in the first storage unit using a secret key; (31, 32, 107-109)

a second storage unit adapted to store the license information including the decrypted licensing condition; (107-109)

a determining unit adapted to determine that the license information is invalid when the total count value of the surfaces scanned by the scanning process counted up by the counting unit exceeds the total number of the original surfaces included in the license information or when the total count value of the surfaces printed by the printing process counted up by the counting unit

exceeds the total number of print surfaces included in the license information, (29, 20, 46, 62)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nakamura to include license encryption/decryption, storage, retrieval, license validity and conditions of Wang since this these all support preventing fraudulent use and are also common best practice to one skilled in the art.

***Response to Arguments***

5. Applicant's arguments filed July 19, 2010 have been fully considered but they are not persuasive due to claims 1-10 having been canceled in favor of new claims 11-13 consisting substantially of new claim language.



***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on M-R 7:30am - 5pm EST, ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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